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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/611,949 | 07/03/2003 | Hiroshi Machara | 03500.015953.1 | 5406 |

5514 7590 03/30/2005

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NEW YORK, NY 10112

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| EXAMINER |
| MCCLENDON, SANZA L |

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| ART UNIT | PAPER NUMBER |
| 1711 | |

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,949

Applicant(s)

MAEHARA, HIROSHI

Examiner

Sanza L. McClendon

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2,3,5,12 and 13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/987,790.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

- 1) In response to the Amendment received on December 09, 2004, the examiner has carefully considered the amendments. The examiner acknowledges the cancellation of claim 6.

Response to Arguments

- 2) Applicant's arguments, see Amendment, filed December 9, 2004, with respect to the rejection(s) of claim(s) 1-5 and 1013 under 35 USC 102(b) as being anticipated by Bailey et al (4,476,255) and the rejection of claims 1-6 and 10-13 under 35 USC 102 (b) as being anticipated by Chiquet (4,931,488) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of US 6,653,364 to Maechara.

Double Patenting

- 3) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

Art Unit: 1711

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

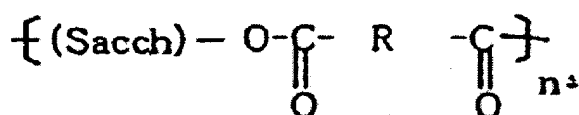
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4, and 7-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,653,364. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to overlapping characteristics in scope. The method for producing a resin composition according to US 6,653,364 is found to include the instantly claimed resin composition, i.e., comprising an agent generating an acid by light and/or an agent generating a base by light in a hydrolysable and biodegradable resin. The difference between the patented resin composition within the method and the instantly claimed resin composition is that the biodegradable resin having the instantly claimed structure as found in instant claim 1. However US 6,653,364 fully teachings a biodegradable resin having the same structure in column 2, as well as, the same definitions, see columns. In addition, the disclosure of 6,653,364 teaches the amount of acid generating agent and/or base generating agent in column 4, lines 62-64, which corresponds to the amount of the same in instant claim 4. The instantly claimed methods of claims 10-11 are also taught by the disclosure of 6,6653,364—see column 2, lines 1-5 and lines 17-30.

Therefore, the examiner deems it would have been obvious for an artisan of ordinary skill in the art at the time of the invention to prepare a resin composition comprising an agent generating an acid by light and/or an agent generating a base by light in a hydrolysable and biodegradable resin having the structure as found in instant claims 1, 7 and 8-9 from the teachings of US 6,653,364, see column 1, lines 50 to the end; column 2, lines 17-22 and lines 55-60; column 4, lines 62-64; and column 3, lines 1 to the end. In addition, a skilled artisan would have found the method of treating said resin composition per instant claims 10-11 obvious from the teachings as found in column 2, lines 17-30.

Allowable Subject Matter

- 4) Claims 2-3, 5, and 12-13 are allowed.
- 5) The following is an examiner's statement of reasons for allowance: The primary reasons for allowance is the inclusion of the hydrolysable and biodegradable resin having the structure



in all the claims. The prior art made of record teaches similar methods, however these prior art methods fail to expressly teach and/or fairly suggest resin compositions comprising a resin having the structure as found in the instant claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

- 6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sanza L. McClendon

Examiner

Art Unit 1711

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